

## REMARKS

Claims 1-26 are currently pending in this application. By this Amendment, claims 1 and 19 have been amended. The amended claim set is provided herewith. Claims 1-18 are under examination herein.

Applicant respectfully submits that this amendment should be entered because the issues raised herein are ones that have been previously considered and the amendments leave the case in condition for allowance.

### § 103 Rejection of the Claims

Claims 1-18 have been rejected under 35 U.S.C. § 103 by Lux, U.S. Patent No. 5,928,070, in view of Emerson, U.S. Patent Publication No. 2003/0226318. Although Applicant does not necessarily agree with this rejection, claim 1 (and 19) has been amended herein. Applicant respectfully traverses this rejection, and will address the rejection under 35 U.S.C. § 103 as if it was raised with respect to the newly amended claim set.

Claim 1 has been amended to specify that “the first portion is configured to form a tread surface of the stair tread cover and the second portion is configured to contact the front edge of a step when the stair tread cover is placed on a step”.

According to MPEP § 2142, three basic criteria must be met in order to establish a *prima facie* case of obviousness. First, the prior art reference (or references when combined) must teach or suggest all of the elements of the rejected claims. Second, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success.

Applicant respectfully asserts that a *prima facie* case of obviousness cannot be shown because Lux, Emerson, or the combination thereof teach or suggest all of the elements of the amended claim. Second, a *prima facie* case of obviousness cannot be shown because there is no suggestion or motivation to modify Lux, Emerson, or the combination thereof to obtain the claimed invention. The structural difference between the claimed invention and the prior art patentably distinguishes the claimed invention from the prior art. Applicant therefore respectfully requests that this rejection be withdrawn in light of the amendments and comments made herein.

Applicant also specifically notes with respect to claim 10, that the Final Office Action did not address the subject matter of claim 10. Applicant respectfully submits that the combination of Lux and Emerson certainly does not render claim 10 obvious because nothing in Lux or Emerson even discloses a colorant, and certainly does not disclose a yellow colorant. A yellow colorant would be advantageous to a stair tread cover because the of added safety of the bright color. A bright color, or any color, would not have been important in the abrasive articles of Lux and Emerson.

Applicant also notes with respect to claim 11, that the Final Office Action did not address the subject matter of claim 11. Applicant respectfully submits that the combination of Lux and Emerson certainly does not render claim 11 obvious because nothing in Lux or Emerson discloses or suggests the inclusion of a graphic on the abrasive article. A graphic would be advantageous to a stair tread cover because it could be utilized to provide warning messages, for example, which would increase the safety of the stair tread cover. This would not have been important to the abrasive articles of Lux or Emerson.

**Conclusion**

Applicant also notes that there may be other arguments which were not presented herein, and Applicant does not concede those arguments by not having presented them herein. Applicant also does not necessarily agree with the correctness of statements made in the Office Action that were not rebutted herein.

In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 651.259.6702 or by E-mail at [anelson@cnwiplaw.com](mailto:anelson@cnwiplaw.com) with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 50-3964.

Respectfully submitted,

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